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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/458,132	02/16/00	SPRAGUE W	SPRAGUE-REI-

EXAMINER
GEHMAN, B

ART UNIT	PAPER NUMBER
3728	11

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/458,132	Sprague et al
	Examiner	Art Unit
	Gehman	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 12/15/00 and 2/5/01

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-5, 7-11 and 13-14 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) 1-4 is/are allowed.

6)☒ Claim(s) 5, 7-11 and 13-14 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☐ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other:

1. The abstract of the disclosure is objected to because in lines 1 and 2, there are words misspelled in each line. Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities: In the proposed amendment to the specification at page 7, line 17, the last three lines thereof, the word "the" is misspelled twice.

Appropriate correction is required.

3. The reissue filing of December 9, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the paragraphs added directed to U.S. Patent Nos. 5,918,909, 5,609,253, 5,427,832, 3,773,2515,294,041 and 5,376,048 on pages 2-4, the reference to "with exemplary dimensions of approximately" at line 11 of page 7, the reference to "approximately" at line 12 of page 8, the change from "generally" to "preferably" at line 15 of page 9, the change from "exposing the magnetic stripe 20" to "thereby leaving the magnetic stripe 20 normally exposed" at lines 14-15 of page 10 and the statement made by the paragraph added at the end of the original disclosure on pages 11-12.

With respect to the discussion of the prior art references, applicants were certainly unaware of 5,918,909 as of August 9, 1996, since the patent did not issue until July 6, 1999. It is

queried how applicants erred in the original application by not commenting on a patent that did not issue until nearly three years after the filing of their application? With respect to the remaining discussed patents, such were brought to applicants attention during the prosecution of the applicants previous application, and were not apparently known to applicants prior to their filing date of August 9, 1996. Accordingly, discussion of all the patents now presented for discussion would comprise new matter relative to the original filing date.

With respect to the "approximately" language added to pages 7 and 8, such is new matter since applicants did not originally disclose the dimensions to be approximations.

With respect to the change from "generally" to "preferably", the terms are not synonymous, as the new term indicates an advantage to the printing the original term does not.

With respect to the change from "exposing" to "normally exposed", such is a change in degree for the exposure occurring to being a possibility.

With respect to the last paragraph, this proposal of the scope the invention was not originally expressed and to do so now would comprise new matter.

4. Claims 5, 7-11 and 13-14 are finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have for the first time, in the arguments presented December 15, 2000, identified that the reissue claims are directed to the

"embodiment" as shown in Figures 4-7. However, these Figures do not show a single embodiment, but rather individual component parts of the embodiment of Figures 1-3 separated into constituent parts, represented by Figures 4-5 and 7, with Figure 6 being a later arrangement of Figures 4-5. Applicants identify the portion claimed in claims 5, 7-11 and 13-14 as with a data card included therein, indicating Figures 4-5 only as representing the claimed structure. However, the arrangement of Figures 4 and 5 do not include a transparent layer as also set forth, as such has been removed as part of the constituent part of Figure 7. Accordingly, if claims 5, 7-11 and 13-14 are directed to the arrangement of Figures 4 and 5, such does not include a transparent layer as set forth in claim 5 according to the original disclosure, and to claim such as part of Figures 4 and 5 comprises new matter. In addition, the recitation as to the aperture "bordered on four sides" is not found in the embodiment of Figures 4 and 5, and therefor claim 9 recites new matter. In addition, the perforation intersecting the diecut transparent window" is not seen to exist in the arrangement of Figures 4 and 5.

5. Claims 5, 7-11 and 13-14 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, lines 2, 7 and 8, "said data card" lacks clear antecedent basis, as the phrase in line 1, "A data card display package for displaying a data card..." does not positively define a data card as a component, and renders the subsequent reference to"said data card" to be indefinite whether applicant is referring to an included card or

inferring the imaginary card of line 1. The opening preamble --A data card display package displaying a data card...-- would indicate a combination, or the initial recitation positive recitation of a card at line 10 should be --a said data card--.

In claim 11, lines 1-4 repeat the recitation of parent claim 5, comprising double recitation. In line 4, "the first and second sides of said data card" lack antecedent basis.

6. Claims 5, 7-11 and 13-14 are finally rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein , Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As stated in *Hester v. Stein, Inc.*, the court held that the recapture rule can be triggered by argument alone. The claims filed August 9, 1996, the arguments filed November 13, 1997 and the finally agreed-to claims in parent application Serial No. 08/694,597 are relied on to indicate the

original intent of applicants. **If the limitations now omitted or broadened in its description in the pending claims of the present reissue were originally presented, argued, or stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation is subject matter previously surrendered by applicant and impermissible recapture exists. In reviewing the evidence indicated in the parent application, applicant's arguments relied on the data card display pack being constructed of a one piece board with a diecut transparent window, the board folded securing a data card therebetween employing adhesive, the board including a quick release perforation feature for opening to reveal the magnetic stripe of the data card, the quick release perforation feature for opening including a bottom line of perforations intersecting the diecut transparent window, the one piece board being printed in one pass to provide data on front and back sides of the board. All of applicants' added reissue claims 5, 7-11 and 13-14 provide broadening aspects to the claims with respect to the claimed embodiment of Figures 1-3 that were clearly argued in the original application to overcome the rejections made in the original application, as expressed in applicants remarks found in Paper No. 9, submitted November 13, 1997. The claims as written can read only on the embodiment of Figures 1-3, as the individual constituent parts of Figures 4-5 and 7, respectively, do not consist of the structure claimed.** The omission or broadening in scope of the instant claims relative to a folded one piece board, the board including a diecut transparent window, a data card being included in the folded board, adhesive included to secure the folded

board to itself, the board including a quick release perforation feature for opening to reveal the magnetic stripe of the included data card, the one piece board being printed in one pass to provide data on front and back sides of the board are related to subject matter surrendered in the original application. Applicant is attempting to recapture claims of broader scope than that which applicant presented as being patentable in view of the original filing of claims, the response filed November 13, 1997 and the finally agreed-to allowed claims in the parent application. Applicants originally presented narrower claims and then further narrowed the claims for the purpose of obtaining allowance in the original prosecution, and applicants are now precluded from recapturing subject matter previously surrendered. The earlier prosecution constitutes an admission by applicants that the original and added limitations were necessary to overcome the prior art. The pending claims are broader than the allowed claims 1-4 in numerous aspects relevant to the prior art rejection and related to surrendered subject matter (any subject matter broader in any aspect than allowed claims 1-4 of the original application). Accordingly, impermissible recapture exists, and the pending claims other than 1-4 are rejected under 35 U.S.C. 251, based on recapture.

Applicants are required to cancel the new matter in the reply to this Office action.

7. Applicant's arguments filed December 15, 2000 and February 5, 2001 have been fully considered but they are not persuasive. The language objections as to being not commensurate with the original disclosure in the original intent are maintained. The references to the prior art

newly added to the specification have not been deleted, and remain objected to as new matter.

The pending claims are not seen to accurately reflect the arrangement of Figures 4 and 5, as argued, and in view that they read on Figures 1-3, they constitute recapture of features argued in the response of November 13, 1997 to be distinguishing.

8. Applicant's amendment and newly presented arguments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to

the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579 or (703)305-3580. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Gehman of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Bryon Gehman whose telephone number is (703) 308-3866.

BPG

February 28, 2001

Bryon P. Gehman
Primary Examiner